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REMARKS

Claims 1-56 are pending in the present application. Claims 10, 11, 32, and 33 have been withdrawn, Claims 12, 15-20, 34, 37-42, and 51-56 have been cancelled and Claims 1, 13, 14, 23, 35, and 36 have been amended, leaving Claims 1-9, 13, 14, 21-31, 35, 36, and 43-50 for consideration upon entry of the present Amendment.

Claims 1 and 23 have been amended to particularly recite the structure of the claims poly(diorganosiloxane) as described in the Specification on page 18, lines 1-11 and Claims 12 and 34. No new matter has been introduced by these amendments. Reconsideration and allowance of the claims is respectfully requested in view of the above amendments and the following remarks.

The present Amendment is in response to an Office Action that was mailed to John B. Yates of General Electric despite a Change of Correspondence Address that was filed on January 8, 2002. A copy of the Change of Correspondence Address is attached hereto. Applicants respectfully request that all subsequent correspondence be addressed to Cantor Colburn LLP as indicated in the Change of Correspondence Address.

Claim Rejections Under 35 U.S.C. § 102(b)

Claims 1-9, 12-31, 34-43, and 46-50 stand rejected under 35 U.S.C. § 102(b), as allegedly anticipated by EP 921 161. Applicants respectfully traverse this rejection.

EP 921 161 discloses a composition comprising a polyetherimide resin, an aromatic polycarbonate resin, and a functionalized polysiloxane polymer (Col. 1, lines 30-36). The Examiner has asserted that at page 6, lines 43 to 45, EP 921 161 suggests the use of a carbonate ester and thus EP 921 161 suggests the use of a polycarbonate ester. Applicants earnestly disagree.

EP 921 161 teaches the use of carbonate esters in the formation of the polycarbonate. In particular, EP 921 161 teaches that a polycarbonate may be made by reacting a carbonate precursor with a dihydric phenol. Examples of carbonate precursors are carbonyl halide, carbonate ester, or a haloformate. (Page 6, paragraphs 24-26) The carbonate precursor reacts with the dihydric phenol under appropriate conditions to form a polycarbonate. The reaction of a carbonate ester and a dihydric phenol does not result in a polycarbonate ester.

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In contrast, a polycarbonate ester comprises not only repeating polycarbonate units but also comprises recurring carboxylic chain units. (Page 11, lines 21-25) Polycarbonate esters are made by the reacting a carbonate, such as diphenyl carbonate, with a mixture of dihydric phenols and ester precursors such as diphenyl derivatives of isophthalates and terephthalates. Clearly polycarbonate esters comprise two chemically different types of repeating units and require three different types of starting materials in contrast to polycarbonates which comprise a single type of repeating unit and only require two different starting materials. Given this information, it is clear that EP 921 161 does not suggest polycarbonate esters.

To anticipate a claim, a reference must disclose each and every element of the claim. *Lewmar Marine v. Varient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987). Applicants respectfully assert that EP 921 161 does not disclose polycarbonate esters and hence does not anticipate the pending claims.

Claims 1-9, 12-31, and 43 stand rejected under 35 U.S.C. § 102(b), as allegedly anticipated by EP 704 487. Applicants respectfully traverse this rejection.

EP 704 487 discloses a composition comprising a polyetherimide resin and a thermoplastic siloxane-polyetherimide copolymer. The thermoplastic siloxane-polyetherimide copolymer comprises repeating siloxane units and repeating polyetherimide units.

The amended claims are directed to a poly(diorganosiloxane) that is not a copolymer with polyetherimide. EP 704 487 teaches only the use of a siloxane-polyetherimide copolymer and does not teach or suggest the use of a poly(diorganosiloxane) without polyetherimide units. Thus, EP 304 487 does not anticipate the instant claims.

Applicants respectfully request reconsideration of Claims 1-9, 12-31, 34-43, and 46-50 and withdrawal of the rejection under 35 U.S.C. § 102(b).

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 43 and 44 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over EP 921 161. Applicants respectfully traverse this rejection.

As discussed above, EP 921 161 does not teach or suggest a composition comprising

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a polycarbonate ester. Because EP 921 161 does not teach or suggest a composition comprising a polycarbonate ester, EP 921 161 cannot teach or suggest a method of making a composition comprising a polycarbonate ester as is instantly claimed.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness, i.e., that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996). Because EP 921 161 does not disclose use of a polycarbonate ester EP 921 161 does not disclose all elements of the claimed invention and cannot provide adequate basis for a *prima facie* case of obviousness.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance is requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 07-0862 maintained by Assignee.

Respectfully submitted,

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Attorney Docket: 8CU-5777 (GP2-0004)

Date Mailed: January 18, 2002

Applicant: Sundarraj, et al.

Serial Number: 09/855,052

Date Filed: May 14, 2001

For:

POLYIMIDE BLENDS, METHOD OF MAKING,
AND ARTICLES MADE THEREFROM

Change of Correspondence (1 page); postcard

First Class Mailed to USPTO on: January 18, 2002

Received in the USPTO on: